

Application No. 10/576,020  
Reply to Office Action of March 6, 2009

IN THE DRAWINGS

The attached sheet of drawings includes a legible copy of the original sheet of drawings. The Replacement Drawing Sheet replaces the original sheet.

Attachment: Replacement Drawing Sheet

REMARKS/ARGUMENTS

**Claims Status**

Claims 1-4 and 7-20 are pending. Claims 1, 7, 11-14, 16 and 18 are currently amended. Claims 5 and 6 are canceled without prejudice. Claim 1 is amended to include the subject matter of original claims 5 and 6; accordingly, claims 5 and 6 are canceled. Claim 7 is amended to correct dependency due to the cancellation of claim 5. Claims 11 -14 are amended to clarify that “a solvent” is “a solvent other than water” since the Office asserts that these claims are “indefinite because water is considered to be a solvent” (Office Action, page 2, item 4). Claim 16 is amended to include the subject matter of page 2, lines 34-37 of the specification. Claim 18 is amended to remove the repetition in the phrase “to the to the”, as well as to clarify what is being compared by the inclusion of the phrase “greater than”. No new matter is believed to have been added.

**Specification Objection**

The pressure unit as originally recited in the specification (page 3, line 35) is objected to for failing to be a proper pressure unit. Accordingly, “kg/cm” has been amended to “kg/cm<sup>3</sup>”. As such, Applicants request withdrawal of this objection.

**Drawings Objection**

The single drawing is objected to for lack of clarity. A Replacement Drawing Sheet is submitted herewith that replaces the original drawing sheet with a legible copy of the same drawing. Accordingly, Applicants request withdrawal of this objection.

**§112, 2<sup>nd</sup> Paragraph, Rejections**

Claim 11 (and claims 12-14 dependent therefrom) and claim 18 are rejected as indefinite. As described above (“Claims Status”), claims 11-14 and 18 are currently amended. In view of the amendments, Applicants request withdrawal of these rejections.

**§102(b) Rejection**

Claims 1-5, 7, 11-13, 16, 17 and 20 are rejected under 35 U.S.C. §102(b) as anticipated by *Schaefer* (EP 1300474). Applicants respectfully traverse this rejection.

A. Independent Claim 1

As the subject matter of original claim 6 is not subject to this rejection and independent claim 1 now includes the subject matter of original claim 6, this rejection is believed to have been overcome with respect to original claims 1-5, 7, 11-13 and 20. Applicants make no statement with respect to the propriety of this ground of rejection and in no way acquiesce to the same. Solely to expedite examination, Applicants have amended claim 1 to include the subject matter of original claim 6. Applicants respectfully request withdrawal of the anticipation rejection over claims 1-5, 7, 11-13 and 20.

B. Independent Claim 16

Applicants submit that *Schaefer* does not disclose, expressly or inherently, all of the limitations of claim 16, namely the currently added limitation that “the hollow microspheres of the plastics filling compound are not present on the grain layer where the at least one defect is not present” (see claim 16). As the Office itself has recognized:

“Philip Schaefer (EP 1300474 A1, machine translation) discloses a full grain napa cowhide which exhibits the characteristics with respect to grain pipeyness and water vapor permeability that are required by the automotive industry and upholstery industries, a finish is applied to the grain side of the full grain leather. The finish includes a pigmented layer with a thickness of between 0.015 mm and 0.04 mm and is formed of a stabilized polyurethane and/or polyacrylate dispersion. The dispersion contains microspheres with a

diameter of less than 45  $\mu\text{m}$ , which form primarily closed cells, and at least 10% open cells by volume.” (Office Action, page 3, item 8 - emphasis added).

Applicants submit that such an application by *Schaefer* of a microsphere containing pigment layer, with a certain thickness, is applied to the *entire* grain side of leather, including where defects are not present, because a *pigment* finish would be applied uniformly so that a desirable/marketable, uniformly colored end-product could be obtained. Accordingly, *Schaefer* does not disclose/anticipate Applicants’ claimed leather (claims 16-18) where the hollow microspheres are *not* present on the leather where the defects are *not* present. Therefore, Applicants respectfully request withdrawal of the anticipation rejection over claims 16 and 17.

### **§103(a) Rejection**

Claims 6, 8-10, 14, 15 and 19 are rejected under 35 U.S.C. §103(a) as obvious in view of the combination of *Schaefer* and *Helmut* (DE 3921145). Applicants respectfully traverse this rejection.

#### **A. Independent Claim 1**

As explained above (“§102(b) Rejection”, Part A), claim 1 now includes the subject matter of original claim 6 (i.e., pressure roll is heated to a temperature of 120-180°C). The Office asserts that *Schaefer* discloses the use of “an embossing roll with a temperature between 80 to 120°C (Col. 5, ¶0021)” and consequently concludes that “choosing the overlapping portion, of the range taught in the prior art and the range claimed by the applicant, has been held to be a *prima facie* case of obviousness” (Office Action, paragraph bridging pages 5-6).

First, Applicants submit that the Office has not put forth a *prima facie* case of obviousness based on overlapping ranges for the following reasons. The alleged point of overlap between Applicants’ claims and *Schaefer* is exactly 120°C; however *Schaefer*

discloses a temperature range “between” 80 to 120°C. According to the plain meaning rule (MPEP 2111.01), the term “between” is interpreted according to its plain meaning unless a definition to the contrary were given in the disclosure. As *Schaefer* does not impart a special definition to the term “between”, one skilled in the art would interpret the term “between” according to its plain meaning of “the space separating two points”. As such, 120°C is not included. Accordingly, given the absence of the alleged point of overlap between Applicants’ claims and *Schaefer*, a *prima facie* case of obviousness based on overlapping ranges as put forth by the Office does not exist.

Second, even if the Office takes the position that “between” encompasses the endpoints and as such continues to allege that a *prima facie* case of obviousness based on overlapping ranges does exist, Applicants submit that *Schaefer* does not render obvious Applicants claims for the following reasons. *Schaefer* discloses a “preferred” working temperature range of the embossing roll to be “*between* 80 to 120°C”. Accordingly, one skilled in the art would have no motivation to look to temperatures at or especially *above* 120°C. Furthermore, courts have held that where, as here, the prior art disclosure suggests the outer limits of the range of suitable values, and that the optimum resides within that range, and where there are indications elsewhere that in fact the optimum should be sought within that range, the determination of optimum values outside that range may not be obvious (*In re Sebek*, 465 F.2d 902, 175 USPQ 93, 95 (CCPA 1972)). Thus, without any motivation to consider temperatures at or especially *above* 120°C, Applicants’ claimed temperature range is not rendered obvious by *Schaefer*.

Lastly, it should be noted that *Helmut* does not fulfill any of the deficiencies of *Schaefer* as discussed above. This is also evidenced by the Office’s reliance on *Helmut* solely for its disclosure of particle sizes with respect to claim 8. Accordingly, *Schaefer* and

*Helmut*, alone or in combination, do not render obvious Applicants' claimed process (i.e., claims 1-4, 7-15, 19 and 20) including a pressure roll temperature of 120-180°C.

B. Independent Claim 16

As explained above ("§102(b) Rejection", Part B), *Schaefer* is silent with respect to a treated leather where the hollow microspheres are not present on the leather where the defects are not present. Accordingly, as *Schaefer* can not be considered to suggest that which it is silent on, Applicants submit that *Schaefer* does not render obvious Applicants' claimed leather product (i.e., claims 16-18) which includes exactly that which *Schaefer* neither discloses nor suggests. Furthermore, *Helmut* does not fulfill this deficiency of *Schaefer*. Accordingly, *Schaefer* and *Helmut*, alone or in combination, do not render obvious Applicants' claimed leather (i.e., claims 16-18).

**Conclusion**

Applicants submit that all now-pending claims are in condition for allowance. Applicants respectfully request the withdrawal of the objections and rejections and passage of this case to issue.

Respectfully submitted,

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